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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Alexander D. S. ELLIN et al.

Application No.: 10/500,716

Filed: July 6, 2004

For: LASER MARKING

On Appeal from Group: 3742

Examiner: S. HEINRICH

Docket No.: 120299

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

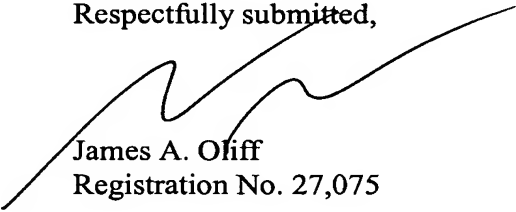
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In response to the Notice of Non-Compliant Appeal Brief (copy attached) mailed on May 29, 2009, a corrected copy of the Brief on Appeal is attached hereto.

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Respectfully submitted,



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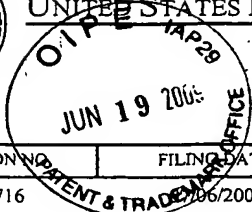
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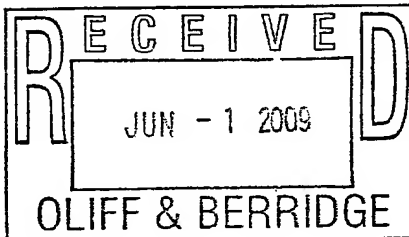
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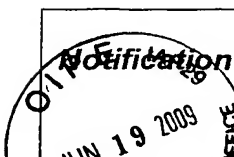
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DUE DATE

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 Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 10/500,716	Applicant(s) ELLIN ET AL.	
	Examiner S. Heinrich	Art Unit 3742	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 25 August 2008 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

c(5) The summary of claimed subject matter does not refer to claims (1,19) on appeal explicitly to the specification by page, and line numbers and to the drawings if any.
The entire brief is not required, only the section that was found defective..

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Alexander D. S. ELLIN et al.

Group Art Unit: 1793

Application No.: 10/500,716

Examiner: S. HEINRICH

Filed: July 6, 2004

Docket No.: 120299

For: LASER MARKING

CORRECTED BRIEF ON APPEAL

Appeal from Group 3742

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TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST	1
II. RELATED APPEALS AND INTERFERENCES	2
III. STATUS OF CLAIMS	3
IV. STATUS OF AMENDMENTS	4
V. SUMMARY OF CLAIMED SUBJECT MATTER	5
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL	8
VII. ARGUMENT	9
A. 35 U.S.C. §103(a) Obviousness	9
B. Claims 1 and 19 Are Not Obvious Over Appellants' Admitted Prior Art (AAPA) In View Of DE 19608937 (DE'937) And Neev, U.S. Patent No. 6,156,030	12
1. The References That Do Disclose A Metrological Scale Fail To Suggest Using Ultra-Short Pulses	12
a. AAPA Discloses Problems That Appellants Solve	12
b. DE'937 Teaches Away From Using Ultra-Short Pulses	13
2. The Only Reference That Mentions Ultra-Short Pulses Is Directed To Non-Analogous Art	14
3. Only Improper Hindsight Reasoning Could Have Been Used To Combine Features From A Metrological Scale With Features Used In A Biomedical Application	15
4. The Applied Art As A Whole Fails To Suggest Trying The Combination Of Features	15
5. Conclusion	18
VIII. CONCLUSION	19
APPENDIX A - CLAIMS APPENDIX	A-1
APPENDIX B - EVIDENCE APPENDIX	B-1
APPENDIX C - RELATED PROCEEDINGS APPENDIX	C-1

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Renishaw PLC, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 016022, Frame 0666.

II. RELATED APPEALS AND INTERFERENCES

A Notice of Appeal was filed on April 16, 2007 and an Appeal Brief was filed on June 18, 2007. The Examiner withdrew the Appeal before a Board Decision on the merits.

There are no other prior or pending appeals, interferences or judicial proceedings, known to Appellants, Appellants' representative, or the Assignees, that may be related to, or that will directly affect or be directly affected by or have a bearing upon, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-36, 42 and 43 are on appeal.

Claims 1-36, 42 and 43 are pending.

No claims are allowed.

Claims 1-36, 42 and 43 are rejected.

Claims 37-41 are cancelled.

IV. STATUS OF AMENDMENTS

A Final Rejection was mailed on March 13, 2008. A Notice of Appeal was filed in reply to the Final Rejection. The claims were last amended with the December 26, 2007 Amendment, and have been entered as evidenced by the March 13, 2008 Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claims relate to a method and an apparatus that produce precision marks for a metrological scale. Instead of using a laser that generates relatively long pulses to produce scale markings, Appellants teach using a laser that emits "ultra-short" pulses. The ultra-short pulses remove material from a substrate by a different ablation mechanism than that which was previously used. In particular, such ultra-short pulses ablate material without the material passing through a molten stage (i.e., the material is sublimated or ejected from the surface as minute solid particles). Appellants can thus reduce thermal expansion effects that can be associated with using lasers that generate shorter pulses and therefore increase the accuracy of the scale that is produced.

According to a first exemplary aspect as recited in independent claim 1 and as illustrated in Figs. 1-3e, for example, a method of producing precision marks (28a-28e, Figs. 3a-3e) for a metrological scale (10), employing an apparatus including: a scale substrate (ribbon, page 6, line 28-page 7, line 6) to be marked at repeated instants by a laser (21, Fig. 2) and thereby forming a metrological scale (10); a laser (21) operable so as to provide light pulses for forming scale markings (28a-28e) at the substrate (ribbon); a displacement device (pinch rollers 20, 22, Fig. 2 and page 7, line 29-page 8, line 20) for causing relative displacement between the substrate (ribbon) and the location at which the light is incident on the substrate (ribbon); and a controller (200, Fig. 1) for controlling the relative displacement and the laser (21), includes the steps, in any suitable order, of:

operating the displacement mechanism (pinch rollers 20, 22) so as to cause relative displacement between the substrate (ribbon) and the light (from laser 21);

using the controller (200) to control the relative displacement (page 9, lines 1-27) and to operate the laser (21) so as to produce light pulses at the substrate (ribbon), (as illustrated in Figs. 3a-3e);

characterized in that:

the laser (21) produces a plurality of ultra-short output pulses (pulse lengths below approximately 4 picoseconds) of a fluence (beam energy (F)) at the substrate (ribbon) such that the metrological scale marks (28a-28e) are formed by laser ablation (page 10, lines 1-9), wherein the plurality of ultra-short output pulses (pulse lengths below approximately 4 picoseconds) have a duration such that the scale markings (28a-28e) are formed on the scale substrate (ribbon) by a laser ablation mechanism in which the molten stage is omitted (page 17, lines 16-26, parameters are all chosen to keep the temporary bulk temperature rise at the ablation area to less than about 6°C).

According to a second exemplary aspect as recited in independent claim 19 and as illustrated in Figs. 1-3e, for example, an apparatus for producing precision marks (28a-28e, Figs. 3a-3e) for a metrological scale (10) includes: a scale substrate (ribbon, page 6, line 28-page 7, line 6) to be marked at repeated instants by a laser (21, Fig. 2) and thereby forming a metrological scale (10); a laser (21) operable so as to provide light pulses for forming scale markings (28a-28e) at the substrate (ribbon); a displacement device (pinch rollers 20, 22, Fig. 2 and page 7, line 29-page 8, line 20) for causing relative displacement between the substrate (ribbon) and the location at which the light is incident on the substrate(ribbon); and a controller (200, Fig. 1) for controlling the relative displacement and for operating the laser (21) so as to produce light at the substrate (ribbon), characterized in that the pulses of light produced by the laser (21) are ultra-short pulses (pulse lengths below approximately 4 picoseconds) of a fluence (beam energy (F)) at the substrate (ribbon) such that the metrological scale marks (28a-28e) are formed by laser ablation (page 10, lines 1-9), wherein the plurality of ultra-short output pulses (pulse lengths below approximately 4 picoseconds) have a duration such that the scale markings (28a-28e) are formed on the scale substrate (ribbon) by a laser ablation mechanism in which the molten stage is omitted (page 17, lines

16-26, parameters are all chosen to keep the temporary bulk temperature rise at the ablation area to less than about 6°C).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

1) Independent claims 1 and 19 were rejected under 35 U.S.C. §103(a) over Appellants' admitted prior art (AAPA) in view of DE 19608937 (DE'937) and Neev, U.S. Patent No. 6,156,030.

The rejection of dependent claims 2-18, 20-36, 42 and 43, which all depend directly or indirectly from either independent claims 1 and 19, are not being presented for appeal.

VII. ARGUMENT

The following grounds of rejection are presented for review:

1) Independent claims 1 and 19 were rejected under 35 U.S.C. §103(a) over Appellants' admitted prior art (AAPA) in view of DE 19608937 (DE'937) and Neev, U.S. Patent No. 6,156,030.

A. 35 U.S.C. §103(a) Obviousness

In the absence of an anticipatory prior art reference, the issue becomes whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103(a). In determining obviousness, the following four factors must be considered: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) any secondary considerations evidencing non-obviousness, such as commercial success, copying, long felt but unsolved needs, failures of others, unexpected results, etc. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1391 (2007), citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

In *KSR*, the Supreme Court confirmed that, in evaluating obviousness, "an expansive and flexible" approach is to be taken, *i.e.*, "rigid and mandatory formulas" are improper. 82 USPQ2d at 1395-97. More specifically, the Court indicated that combining prior art elements to perform their respective established functions is likely to be obvious when it does no more than yield predictable results. *Id.* at 1395. Indeed, if a design need or market pressure to solve a problem having a finite number of identified, predictable solutions provides good reason for an ordinarily skilled person to pursue the known options within his or her technical grasp, and if such pursuit leads to the anticipated success, "it is likely the product not of

innovation but of ordinary skill and common sense" and "[i]n that instance the fact that a combination was obvious to try might show that it was obvious under §103." *Id.* at 1397.

Conversely, when the prior art teaches away from combining known elements, discovery of a successful way to combine them is more likely not obvious. *Id.* at 1395.

Obviousness is not shown merely by demonstrating that each of the elements of a claimed combination was known in the art. Rather, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine [or modify] the elements" as claimed. *Id.* at 1396. However, "any need or problem known in the field of endeavor at the time of invention and addressed by the patent" can provide such a reason, as the patentee's particular motivation/purpose does not control. *Id.* at 1397. Also, a precise teaching of claimed subject matter is not needed, as familiar items have obvious uses beyond their primary purposes, and one must consider inferences/creative steps that a person of ordinary skill ("a person of ordinary creativity, not an automaton") would have employed. *Id.* at 1396-97.

A long-standing obviousness test used by the Federal Circuit is the "teaching-suggestion-motivation" (TSM) test, under which a patent claim is proved obvious only if a teaching, suggestion or motivation (*i.e.*, a reason) to combine or modify prior art teachings is found in the prior art, in the nature of the problem, or in the knowledge of a person of ordinary skill in the art. *Id.* at 1391. The Supreme Court in *KSR* confirmed that "[t]here is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis," as long as the TSM test is not applied rigidly or narrowly. *Id.* at 1396-97. According to Federal Circuit decisions consistent with *KSR*, the motivation/suggestion/teaching may but need not be found explicitly in the prior art, and the prior art may but need not be combined or modified for the same reasons contemplated by the inventor. *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (cited with approval in *KSR*, *id.* at 1396). Furthermore, "prior art" is

broader than just the references sought to be combined, and motivation may be established based upon, *inter alia*, basic principles, common knowledge and/or common sense. *DyStar Textilfarben GMBH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360-61, 1367 (Fed. Cir. 2006); *see also Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291, 1294 (Fed. Cir. 2006) (decisions cited by *KSR*, *id.* at 1397, as providing "a broader conception of the TSM test" than the Federal Circuit's erroneous application of the test in *KSR*). Regardless, however, a conclusion of obviousness should be explicitly supported by "articulated reasoning with some rational underpinning" and not "by mere conclusory statements." *See KSR*, *id.* at 1396, *quoting Kahn*.

The circumstances under which prior art may be found to "teach away" from a claimed combination are narrow, *e.g.*, a reference must lead one in a direction divergent from the path taken by a claimed invention and not just disclose an alternative or indicate that a claimed combination resolves a different problem or is less desirable, inefficient or inferior. *KSR*, *id.* at 1399; *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1308 (Fed. Cir. 2006); *In re Fulton*, 391 F.3d 1195, 1200-01 (Fed. Cir. 2004); *Nat'l Steel Car Ltd. v. Can. Pac. Rwy. Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004). Also, the "obvious to try" consideration mentioned in *KSR* dovetails with the motivation analysis in that a skilled artisan not only must have been motivated to combine or modify prior art to achieve a claimed invention, but also must have had a "reasonable expectation of success in doing so." *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1364-69 (Fed. Cir. 2007).

**B. Claims 1 and 19 Are Not Obvious Over Appellants'
Admitted Prior Art (AAPA) In View Of DE 19608937
(DE'937) And Neev, U.S. Patent No. 6,156,030**

**1. The References That Do Disclose A Metrological
Scale Fail To Suggest Using Ultra-Short Pulses**

None of the applied references disclose or suggest a method or an apparatus that combines both a metrological scale and ultra-short output pulses that are used to form precision markings on the metrological scale as recited in claims 1 and 19. In particular, none of the applied references disclose or suggest a method or an apparatus for producing precision marks with a laser that produces a plurality of ultra-short output pulses of a fluence at the substrate such that the metrological scale marks are formed by laser ablation, wherein the plurality of ultra-short output pulses have a duration such that the scale markings are formed on the scale substrate by a laser ablation mechanism in which the molten stage is omitted, as recited in claims 1 and 19.

The first category of applied references discussed below are those that are related to the manufacture of a metrological scale having precision scale markings (AAPA and DE'937). The second category only includes Neev, which is the only reference that mentions ultra-short laser pulses. However, Neev applies the ultra-short laser pulses for a biological application (e.g., laser eye surgery). Reviewing the applied references as a whole, the use of ultra-short pulses to produce precision markings on a metrological scale is in no way obvious when the only reference that actually mentions ultra-short laser pulses applies the ultra-short pulses to a different field of endeavor.

a. AAPA Discloses Problems That Appellants Solve

The references cited in AAPA (U.S. Patent No. 4,932,131 and JP 5169286) state that it is known to form markings for a metrological scale using a laser. However, the references cited in AAPA fail to provide any disclosure or suggestion with regard to using a pulsed laser that generates short pulses or describe the process by which the mark is formed. In particular,

the references cited in AAPA fail to disclose or suggest using ultra-short pulses or operating in a laser ablation regimen in which material is removed by a laser ablation mechanism in which the molten stage is omitted.

b. DE'937 Teaches Away From Using Ultra-Short Pulses

DE'937 discloses a method for marking a substrate using a pulsed laser. DE'937 uses an Excimer laser that produces pulses of approximately 20 ns (para. 4 of translation) and the laser pulse is used to melt the surface of the substrate (para. 8). The re-solidification of the melt provides a region of different surface roughness that has different optical properties to the surrounding material. Although DE'937 mentions that pulses of a much shorter duration can be used, the duration is selected in order to avoid heat dissipation from the process area (i.e. ensure that melting effect occurs efficiently).

As disclosed in DE'937, the laser pulse that is used to form scale marks must always be sufficiently long so that melting occurs. Otherwise, the re-solidification stage would not happen.

No where in DE'937 is it stated that DE'937 uses ultra-short pulses, and the Final Rejection fails to specifically identify where DE'937 states that ultra-short pulses are used. Furthermore, pulses of approximately 20 ns as used in DE'937 is not the same as ultra-short pulses as understood by a person of ordinary skill in the relevant field.

In addition, DE'937 explicitly requires a melting effect to occur. Because a melting effect is explicitly required, one skilled in the art reading DE'937 would have actually been led away from using ultra-short pulses having a duration such that the scale marks are formed on a scale substrate by a laser ablation mechanism in which the molten stage is omitted, as recited in claims 1 and 19. In other words, it would not have been reasonably predictable to one skilled in the relevant field to read DE' 937 and consider using the ultra-short pulses that

are used in a different field of endeavor (the biomedical application of Neev) given that DE'937 explicitly requires a melting effect to occur on the substrate of a metrological scale.

2. The Only Reference That Mentions Ultra-Short Pulses Is Directed To Non-Analogous Art

Taking the disclosures of AAPA and DE'937 as a whole, there is no disclosure with regard to using ultra-short laser pulses with a metrological scale. Because there is no disclosure with regard to using ultra-short laser pulses, there is no reason that would have prompted a person of ordinary skill in the relevant art to use ultra-short pulses having a duration such that the scale marks are formed on a scale substrate by a laser ablation mechanism in which the molten stage is omitted, as recited in claims 1 and 19. The only reference remaining, Neev, fails to overcome the deficiencies of AAPA and DE'937 because Neev is non-analogous art.

"Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR* Neev is not reasonably pertinent because Neev logically would not have commended itself to an inventor's attention in considering his or her invention as a whole.

Neev is directed to providing a laser processing technique for biomedical (e.g., laser eye surgery) or silicon processing purposes that reduces collateral damage to human tissue. Reducing collateral damage to human tissue would not have reasonably commended itself to an inventor's attention when considering metrological scales.

In addition, metrological scales and human tissue are from different fields of endeavor. Moreover, human tissue is not reasonably pertinent to the problem with which Appellants were concerned in connection with the claimed metrological scale. Thus, Appellants respectfully submit that Neev, which is directed to a biological application, is non-

analogous art. See also MPEP §2141.01(a); and *In re Clay*, 966 F.2d. 656, 658-60 (Fed. Cir. 1992).

During a May 15, 2008 personal interview, Examiner Heinrich stated that Neev is analogous art because Neev uses lasers. Appellants disagree. Neev cannot reasonably be from the same field of endeavor as Appellants' invention or the other applied art simply because Neev uses laser. In addition, the Examiner's analysis in simply citing lasers cannot be reasonably supported by *KSR*, *In re Clay* or MPEP §2141.01(a);

3. Only Improper Hindsight Reasoning Could Have Been Used To Combine Features From A Metrological Scale With Features Used In A Biomedical Application

Second, and regardless of the previous point, it is also improper to combine AAPA and DE'937's metrological scale with Neev's biological application because such combination involves impermissible hindsight using knowledge gleaned only from Appellants' disclosure. Such hindsight reconstruction of the claimed invention is improper. See MPEP §2145(X)(A).

During the May 15, 2008 personal interview, Examiner Heinrich was questioned as to why he was motivated to combine AAPA and DE'937 with Neev. In particular, Examiner Heinrich was questioned as to why he had to apply a reference that relates to a biomedical application (Neev), and what made him consider using such a reference with references directed to a metrological scale. The Examiner could not provide a reasonable explanation. The only explanation that was provided was that both DE'937 and Neev use lasers. Given the vast application of lasers, Appellants assert that knowledge gleaned only from Appellants' disclosure (which is impermissible hindsight) was used to combine DE'937 and Neev.

4. The Applied Art As A Whole Fails To Suggest Trying The Combination Of Features

Third, and regardless of the previous points, there is no reasonable reason as why it would have been predictable to use Neev's ultra-short pulses with AAPA and DE'937's metrological scale.

Neev is directed to providing a laser processing technique for biomedical (e.g., laser eye surgery) or silicon processing purposes. Neev teaches using a wide range of pulse durations ranging from 1 femto-second to 100 milliseconds (col. 9, lines 62-63). Thus, the pulse duration range mentioned in Neev would encompass ultra-short laser pulses because Neev is directed to using pulses on human tissue. Neev does not describe the formation of any kind of precision metrology markings or formation of a metrological scale because Neev is directed to reducing damage to surrounding tissue in a biomedical application.

As stated on pages 2-3 of the Final Rejection and as asserted during the May 15, 2008 personal interview, the Examiner argues that, because Neev discloses using an ultra-short pulse, it would have been obvious to use the pulse to produce a smaller Heat Affected Zone (HAZ). Applicants respectfully disagree with the Examiner.

Applicants submit that it would not have been predictable at the time of Appellants' invention to a person having ordinary skill in the relevant field to use an ultra-short pulse laser to measurement scale manufacture. Neev uses an ultra-short pulse laser to minimize the heat affected zone (HAZ) and thereby reduce defects on human tissue. Neev is directed at human tissue where damage to the tissue or melting of the tissue is an undesirable effect. However, in the manufacture of metrological scales, some product defects are desired. In fact, prior arts, including DE'937 suggest that laser pulses used to form scale marks must always be sufficiently long so that melting occurs, i.e., a defect of the metal. In other words, AAPA and DE'937 want to use lasers of a long duration in order to melt the surface of the substrate, while Neev wants to use ultra-short pulses (and not lasers of a long duration) in order to avoid damage to the human tissue.

In addition, Neev only discusses using the ultra-short pulse on human tissue, and fails to provide any discussion with regard to forming a scale. Considering AAPA, DE'937 and Neev as a whole, one skilled in the relevant field would be motivated not to use ultra-short

pulses with a metrological scale. In fact, one skilled in the relevant field would have been led away from using ultra-short pulses because Neev states that using ultra-short pulses is expensive and complicated (col. 4, lines 41-58).

Taken as a whole, AAPA, DE'937 and Neev fail to disclose or suggest using ultra-short pulses with a metrological scale. DE'937 wants melting to occur to their metrological, and Neev (which is directed to a different field of endeavor) actually discourages using ultra-short pulses because they are expensive and complicated. Accordingly, even if one of ordinary skill in the relevant field were to combine the teachings of Neev with either of AAPA and DE'937 (which, for reasons discussed above, one skilled in the art would not combine), a person of ordinary skill in the relevant field would avoid using ultra-short pulses with a metrological scale.

Therefore, it would not have been obvious or predictable to one having ordinary skill in the relevant field to use Neev's ultra-short pulses with the combination of AAPA and DE'937 in order to operate in a laser ablation regimen in which material is removed by a laser ablation mechanism in which the molten stage is omitted, as recited in claims 1 and 19.

Accordingly, the Office Action has failed to provide any reason why one of ordinary skill in the art would have derived the combination of features recited in claims 1 and 19 from the applied references in the above-identified first and second categories. Appellants also observe the following:

(a) None of the applied references in the first category refer to Neev's, and vice versa. Thus, there would have been no reason whatsoever for a person of ordinary skill in the art to have consulted Neev.

(b) Even if Neev was consulted by one of ordinary skill in the art (which Appellants assert would not have been obvious), none of the applied references explicitly mention the use of ultra-short laser pulses to generate scale markings or the like. Neev's use

of ultra-short pulses is specific to a biomedical application and the use of ultra-short pulses is expensive and complicated. Motivation thus does not exist from the applied references to consider applying the ultra-short laser system teachings or methods in order to produce a metrological scale.

(c) Any assertion that the applied references would be combined to yield the combination of features recited in claims 1 and 19 is based purely on hindsight. Numerous types of laser systems exist, each producing laser radiation having different properties. The combination of features recited in claims 1 and 19 was developed by the Appellants' novel and non-obvious concept that thermal expansion effects can degrade the precision of metrological scale production and that such effects can be overcome using ultra-short laser pulses. The combination of applied references presented in the Final Rejection is thus based purely on hindsight analysis after gaining knowledge from Appellants' specification.

The combination of features recited in independent claims 1 and 19 are neither disclosed nor suggested by the applied art, nor is there any motivation provided in order to create the combination of features recited in claims 1 and 19.

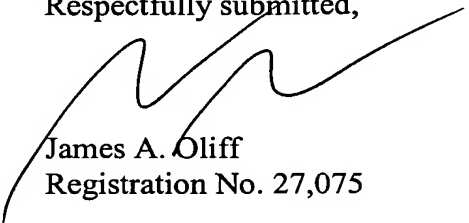
5. Conclusion

As discussed above, the subject matter of independent claims 1 and 19 would not have been rendered obvious by the cited references. For this additional reason, Appellants respectfully request that the rejection be reversed.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-36, 42 and 43 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejection of independent claims 1 and 19 (which results in the reversal of the rejections to dependent claims 2-18, 20-36, 42 and 43).

Respectfully submitted,



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APPENDIX A - CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. A method of producing precision marks for a metrological scale, employing apparatus including: a scale substrate to be marked at repeated instants by a laser and thereby forming a metrological scale; a laser operable so as to provide light pulses for forming scale markings at the substrate; a displacement device for causing relative displacement between the substrate and the location at which the light is incident on the substrate; and a controller for controlling the relative displacement and the laser,

the method comprising the steps, in any suitable order, of:

operating the displacement mechanism so as to cause relative displacement between the substrate and the light;

using the controller to control the relative displacement and to operate the laser so as to produce light pulses at the substrate;

characterised in that:

the laser produces a plurality of ultra-short output pulses of a fluence at the substrate such that the metrological scale marks are formed by laser ablation, wherein the plurality of ultra-short output pulses have a duration such that the scale markings are formed on the scale substrate by a laser ablation mechanism in which the molten stage is omitted.

2. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the substrate is subjected to a bulk temperature rise not exceeding about 6 degrees Celsius at the ablation area as a result of the ablation.

3. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the marks produced contrast optically with unablated substrate.

4. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the substrate is subjected to a bulk temperature rise causing thermal expansion uncertainties at the substrate ablation area below 3 parts per million.

5. A method of producing precision marks for a metrological scale as claimed in claim 3 wherein the optically contrasting marks have an altered reflectivity.

6. A method of producing precision marks for a metrological scale as claimed in claim 5 wherein the reflectivity of the marks is 3 or more times less than the reflectivity of the substrate.

7. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the substrate is flexible.

8. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the substrate is elongate.

9. A method of producing precision marks for a metrological scale as claimed in claim 8 wherein the substrate is a continuous metallic ribbon.

10. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the substrate is of a thickness of less than about 6 mm.

11. A method of producing precision marks for a metrological scale as claimed in claim 10 wherein the substrate is of a thickness of less than about 1 mm.

12. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the said displacement is continuous.

13. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the fluence at the centre center of the incidence is above the threshold for causing ablation by a factor of about 4 to about 12.

14. A method of producing precision marks for a metrological scale as claimed in claim 13 wherein the fluence at the centre of the incidence is above the threshold for causing

ablation by a factor of about e^2 , wherein e is a mathematical constant for a base of natural logarithms.

15. A method of producing precision marks for a metrological scale as claimed in claim 1 further employing a laser light manipulation device, a displacement sensor for sensing the displacement between the substrate and the location at which the light is incident and a reader for determining the distance between two or more markings at the scale wherein the method further comprises:

issuing a signal from the displacement sensor to the controller;

issuing a signal from the reader to controller;

in response to the signals from the sensor and the reader using the controller to control the manipulation device, the displacement, and the repeated instants at which the laser ablates the substrate.

16. A method of producing precision marks for a metrological scale as claimed in claim 15 wherein the displacement is linear movement in one direction and the light manipulation device is operable to cause the location at which laser light is incident at the substrate to move transversely to the said direction.

17. A method of producing precision marks for a metrological scale as claimed in claim 15 wherein the controller is used to further control the manipulation and/or displacement according to known apparatus error information.

18. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the laser light is formed as at least one ellipse where the light is incident the substrate.

19. Apparatus for producing precision marks for a metrological scale comprising: a scale substrate to be marked at repeated instants by a laser and thereby forming a metrological scale; a laser operable so as to provide light pulses for forming scale markings at

the substrate; a displacement device for causing relative displacement between the substrate and the location at which the light is incident on the substrate; and a controller for controlling the relative displacement and for operating the laser so as to produce light at the substrate, characterised in that the pulses of light produced by the laser are ultra-short pulses of a fluence at the substrate such that the metrological scale marks are formed by laser ablation, wherein the plurality of ultra-short output pulses have a duration such that the scale markings are formed on the scale substrate by a laser ablation mechanism in which the molten stage is omitted.

20. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the substrate is subjected to a bulk temperature rise not exceeding about 6 degrees Celsius at the ablation area as a result of the ablation.

21. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the marks produced contrast optically with unablated substrate.

22. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the substrate is subjected to a bulk temperature rise causing thermal expansion uncertainties at the substrate ablation area below 3 parts per million.

23. Apparatus for producing precision marks for a metrological scale as claimed in claim 21 wherein the optically contrasting marks have an altered reflectivity.

24. Apparatus for producing precision marks for a metrological scale as claimed in claim 23 wherein the reflectivity of the marks is 3 or more times less than the reflectivity of the substrate.

25. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the substrate is flexible.

26. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the substrate is elongate.

27. Apparatus for producing precision marks for a metrological scale as claimed in claim 26 wherein the substrate is a continuous metallic ribbon.

28. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the substrate is of a thickness of less than about 6 mm.

29. Apparatus for producing precision marks for a metrological scale as claimed in claim 28 wherein the substrate is of a thickness of less than about 1 mm.

30. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the said displacement is continuous.

31. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the fluence at the centre center of ablation is above the threshold for causing ablation by a factor of 4 to 12.

32. Apparatus for producing precision marks for a metrological scale as claimed in claim 31 wherein the fluence at the centre of ablation is above the threshold for causing ablation by a factor of e^2 , wherein e is a mathematical constant for a base of natural logarithms.

33. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 further comprising a laser light manipulation device, a displacement sensor for sensing the displacement between the substrate and the location at which the light is incident and for issuing a signal from the displacement sensor to the controller and a reader for determining the distance between two or more markings at the scale and for issuing a signal from the reader to controller, the controller being further operable in response to the signals from the sensor and the reader so as to control the manipulation device, the displacement, and the repeated instants at which the laser ablates the substrate.

34. Apparatus for producing precision marks for a metrological scale as claimed in claim 33 wherein the displacement is linear movement in one direction and the light

manipulation device is operable to cause the location at which laser light is incident at the substrate to move transversely to the said direction.

35. Apparatus for producing precision marks for a metrological scale as claimed in claim 33 wherein the controller is used to further control the manipulation and/or displacement according to known apparatus error information.

36. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the laser light is formed as at least one ellipse at the area where the light is incident at the substrate.

42. A method of producing precision marks for a metrological scale as claimed in claim 1 wherein the ultra-short pulses have a duration of less than 4 picoseconds.

43. Apparatus for producing precision marks for a metrological scale as claimed in claim 19 wherein the ultra-short pulses have a duration of less than 4 picoseconds.

APPENDIX B - EVIDENCE APPENDIX

NONE

APPENDIX C - RELATED PROCEEDINGS APPENDIX

NONE